

REMARKS

Claims 1 - 5 are pending in the application and stand rejected. Claims 1 - 5 are amended herein. No new matter has been added by these amendments.

In the Office Action the Examiner rejected 1 - 5 under 35 U.S.C. § 112, second paragraph. In addition, the Examiner rejected claims 1 - 3 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over *Ofusa*, rejected claim 4 under 35 U.S.C. § 103(a) as obvious over *Ofusa*, and rejected claim 5 under 35 U.S.C. § 103(a) as obvious over *Ofusa* in view of *Matsushima*.

Regarding the rejection under 35 U.S.C. § 112, second paragraph, the Examiner argued that claim 1 was indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner argued that the terms "core string," "inner side," and "main" were unclear, that the limitation "the other warps" lacked antecedent basis, and that claim 1 failed to set forth structural and/or chemical limitations of the recited fabrics. Regarding claims 3 and 4, the Examiner noted her preference for the use of common textile terms such as "diameter," "denier," or "tex." Claims 3 and 4 have been amended herein to comport with the Examiner's preferences. No new matter has been added by these amendments.

Regarding claim 1, the claim is amended herein to remove the phrases "the other warps" and "inner side." The term "core string" is defined throughout the specification of the present application (e.g., p. 11, lines 9 - 25). Moreover, the term "tape main portion" is fully described in the specification of the present application (e.g., p. 11, lines 5 - 8; Fig. 1). Finally, amended claim 1 recites not only the physical properties of the components of the fastener tape, but also recites the structural relationships of the

components, as well as the relative relationships of the physical properties. Specifically, amended claim 1 recites, for example, that the warp disposed between the core string and the tape main portion has a thermal coefficient that is higher than that of the foundation warp used for the tape main portion and lower than that of the core string. Accordingly, Applicant respectfully asserts that this rejection has been overcome.

The Examiner rejected claims 1 - 3 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as unpatentable over *Ofusa*. In addition, the Examiner rejected claim 4 under 35 U.S.C. § 103(a) as obvious over *Ofusa*, and rejected claim 5 under 35 U.S.C. § 103(a) as obvious over *Ofusa* in view of *Matsushima*. While the Examiner admits that *Ofusa* fails to disclose a warp disposed between the core string and the tape main portion, where the warp has a thermal contraction coefficient higher than the foundation warp used for the tape main portion and lower than the core string, as recited in amended claim 1, the Examiner argues that such a structure would be inherent.

The Federal Circuit has held that inherent anticipation arises when "the prior art necessarily functions in accordance with, or includes, the claimed limitation." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347 (Fed. Cir. 1999). Moreover, to support an anticipation rejection based on inherency, an examiner must provide factual and technical grounds establishing that the inherent feature *necessarily* flows from the teachings of the prior art. See *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int. 1990). There is no disclosure in *Ofusa* either teaching or suggesting a warp disposed between the core string and the tape main portion, where the warp has a thermal contraction coefficient higher than the foundation warp used for the tape main

portion and lower than the core string, as recited in amended claim 1. Moreover, *Ofusa*, fails to disclose differential thermal contraction coefficients for any of the various elements of the tape fastener.

The Examiner relies on *In re Fitzgerald* for the proposition that the Applicant must prove that *Ofusa* does not teach the recited side fastener tape. The Examiner's reliance on this case is misplaced. In *Fitzgerald*, the question revolved around whether a product having certain functional properties would necessarily result from the process taught in the prior art; specifically, whether a process disclosed in the prior art would result in "said polymer in said patch having a reduced degree of crystallization shrinkage of about 25% or less of its maximum crystallization shrinkage." That is not the case here. Amended claim 1 does not recite functional limitations. Instead, amended claim 1 recites a slide fastener tape comprised of elements having varying physical properties. Specifically, amended claim 1 recites a warp disposed between the core string and the tape main portion, where the warp has a thermal contraction coefficient higher than the foundation warp used for the tape main portion and lower than the core string. Moreover, in the Board decision affirmed by the Court in *Fitzgerald*, the Board noted that the objects of the subject invention and the prior art were commensurate in scope. Here, on the other hand, the objects of the invention in *Ofusa* were to provide a woven fastener stringer that is easily woven, where the structure for attaching elements were formed only on the leg portion of the elements and where the structure has a low profile to permit smooth movement of the slider. An object of the current invention is to prevent puckering in the element-mounting edge portion of the slide fastener tape when the tape is subject to various thermal conditions.

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This object is neither disclosed nor suggested in *Ofusa. Matsushima* fails to remedy any of these deficiencies.

Thus, for at least the above reasons, claim 1, as well as claims 2 - 5 that depend therefrom, are allowable over the cited art.

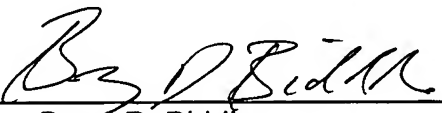
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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